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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/390,583 09/02/99 ANDERSEN P 11527.209

022913
WORKMAN NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY UT 84111

IM22/0604

EXAMINER

COPENHEAVER, B

ART UNIT

PAPER NUMBER

1771

17

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/390,583

Applicant(s)

ANDERSEN ET AL.

Examiner

Copenheaver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed.

See 37 CFR 1.178.

As set forth in MPEP 1455, a list of references to be printed in the reissue patent should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application. Because of the numerous references cited during the original prosecution, the Examiner is requiring that the Applicant submit a listing of each of these references on a PTO-1449 prior to the allowance of this reissue application.

Claims 32-51 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

The newly amended claims do not contain the limitation that the fibrous material has an average fiber length of greater than about 2 mm. It is noted that this limitation was relied on by the applicants in the original prosecution to distinguish over Tiefenbacher et al. See pages 11, first full paragraph to page 13, line 3 of Paper #7 dated March 18, 1996 in U.S. Serial No. 08/327,524, where it is argued that "[e]ach of independent claims 1, 23, 30 and 49 was originally drafted to include the limitation that the 'fibers hav[e] an average fiber length greater than about 2mm'. In contrast, *Tiefenbacher et al* teaches away from the use of fibers larger than 1.5 mm, as

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discussed hereinbelow. The ability to successfully mold a starch-bound article having fibers that have 'an average fiber length greater than about 2 mm' is made possible by the inclusion of pregelatinized starch component in significant quantities within the starch-based composition during the mixing process... This results in much more effective dispersion of the fibers, particularly 'fibers having an average fiber length greater than about 2 mm'... 'Fibers having an average fiber length greater than about 2 mm' are an important component because they provide an important reinforcing function within the molded starch-bound articles... it is clear that *Tiefenbacher et al* fails to teach or suggest the tremendous strengthening effect of the fibers, particularly well-dispersed fibers having an average length greater than about 2 mm."

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of (1) U.S. Patent No. 5,702,787, particularly note claims 1, 19, 36, 37 and 52-54; (2) U.S. Patent No. 5,705,239, particularly note claims 1, 8 and 54; (3) U.S. Patent No. 5,736,209,

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particularly note claims 1, 9 and 42-47; and (4) U.S. Patent No. 6,083,586, particularly note claims 1, 14, 15, 17 and 18. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth in Paper #14.

Applicant's arguments filed on March 23, 2001 have been fully considered but they are not persuasive. All rejections not repeated above are herein withdrawn. Specifically, the rejection over 35 U.S.C. 251 based on applicants' failure to file a divisional application is withdrawn by the present amendment and for the reasons argued in the present response. The 35 U.S.C. 112, second paragraph, rejection over the confusion as to what statutory class of invention is being claimed is withdrawn in view of the present amendment, which makes it clear that a "composite" is now being claimed. Most of the obviousness-type double patenting rejections have been overcome by the present amendment, which requires a specific starch-based matrix/binder material comprising both gelatinized and unmodified, ungelatinized starch materials. The art rejection over WO '186 is withdrawn in view of the present amendment.

↓
The improper recapture rejection under 35 U.S.C. 251 is maintained for the reasons detailed above. The applicants argue that there is an exception that allows for broadening in some respects so long as the claims as a whole are "fundamentally narrower" than the issued claims. The Examiner certainly agrees that the applicants have the ability to obtain broader claims in a reissue application, but that broadening can not recapture subject matter which was argued to make the application claims

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allowable over a rejection made in the application. See *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993), which states that reissue claims that are broader in certain aspects and narrower in others *vis-à-vis* claims canceled from the original application to obtain a patent may avoid the effect of recapture rule if the claims are broader in a way that does **not** attempt to reclaim what was surrendered earlier (Emphasis added). As stated in *In re Clement* (131 F.3d at 1469, 45 USPQ2d at 1164), “[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for **arguments** and changes made in an effort to overcome a prior art rejection” (Emphasis added). This statement in *Clement* was subsequently discussed in *Hester Industries, Inc. v. Stein, Inc.* (142 F.3d 1482 (CAFC 1998)), where the Court observed that surrender of claimed subject matter may occur by *arguments* made during the prosecution of the original patent application *even where there was no claim change made*. The Court in *Hester* held that the surrender which forms the basis for impermissible recapture “can occur through arguments alone.” The argument that since the claims of the present reissue are materially narrower in key aspects such that *Ball* does not apply is not persuasive, because the Court in *Ball* held that the recapture rule bars the patentee from acquiring through reissue claims that are, **in all aspects**, of the same scope as, or are broader in scope than, those claims canceled from the original application to obtain a patent (Emphasis added).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blaine Copenheaver whose telephone number is (703) 308-1261. The examiner can normally be reached on Monday-Friday between 7:30 AM and 4:00 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 and (703) 305-3601.


BLAINE COPENHEAVER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

B. Copenheaver
June 1, 2001